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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,617	11/26/2003	Daniel Freeman	6032.006	7095
7590 05/18/2005 Levisohn, Berger & Langsam LLP 19th Floor 805 Third Avenue New York, NY 10022			EXAMINER SAWHNEY, HARGOBIND S	
			ART UNIT 2875	PAPER NUMBER

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

EK

Office Action Summary	Application No. 10/722,617	Applicant(s) FREEMAN ET AL	
	Examiner Hargobind S. Sawhney	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-12 and 17-29 is/are rejected.
- 7) ☒ Claim(s) 8 and 13-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/6/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claim 3 has been not give patentable weight, as it includes a product-by process limitation "the blank key with a cutout formed via one of cutting or punching". The applicant is advised that patentability of a product does not depend on its method of production.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 26 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Hung (US Patent No.: 5,541,817), hereinafter referred as Hung.

Regarding each of claims 26 and 27, Hung discloses an illuminated key bank 10 (Figure 1) comprising:

- a main body 30 having a blade 20 and a head 30 integral with the blade 20 (Figure 1, column 1, lines 51-54);

Note: the limitation "integral" is sufficiently broad to embrace construction means such as mechanical fastening and welding.

- a casing 36 sealed around the head 30, and the casing 36 receiving a battery 60 (Figures 1 and 4, column 2, lines 4-6, 19 and 20);
- A light source 40 disposed at least partially in the casing 36 (Figures 1 and 4, column 2, lines 5-7);
- the light source 40 selectively electrically connectable to the battery 60 (Figure 1, column 2, line 7); and
- the light source 40 directing light substantially in the direction of blade 20 (Figure 1, column 2, lines 7 and 8).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,2,7,9-11,17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hung (US Patent No.: 5,541,817), hereinafter referred as Hung.

Regarding Claim 1, Hung discloses an illuminated key bank 10 (Figure 1) comprising:

- a main body 30 having a blade 20 and a head 30 integral with the blade 20 as a single piece (Figure 1, column 1, lines 51-54);

Note: the limitation "integral" is sufficiently broad to embrace construction means such as mechanical fastening and welding.

- a cutout formed in the head 30 receiving a battery 60 (Figure 1, column 2, line 16);
- a light source 40 selectively electrically connectable to the battery 60 (Figure 1, column 2, line 7); and
- the light source 40 directing light substantially in the direction of blade 20 (Figure 1, column 2, lines 7 and 8).

However, Hung does not teach the head being integral with the blade as a single piece.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to make the head being integral with the blade as a single piece, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together is a merely a matter obvious engineering choice, and involves only routine skill in the art.

Regarding claims 2,7,9-11,17-19, Hung discloses the illuminated key bank 10 (Figure 1) further comprising:

- the casing 36 permanently sealed around the head 30 and the battery 60 (Figures 1 and 4, column 2, lines 4-6, 19 and 20);
- the light source 40 being a light emitting diode (LED) (Figure 1, column 2, line 7); and

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- the casing 36 conforming to overall profile of the head 30 (Figures 1 and 4); and the casing 32 not increasing the overall profile of the head (Figures 1 and 4);
- the casing 36 comprising an upper housing – the upper half of the casing – , and a lower housing- the lower half of the casing –, matingly secured together (Figure 1, column 2, lines 4-6, 19 and 20);
- the upper and lower housing each including a recess receiving the head 30 (Figures 1 and 4);
- the upper and lower housings – the upper and lower halves of the casing 36 (Figures 1 and 4) - including respective first and second recesses receiving and retaining the light source 40 (Figures 1 and 4);
- the light source 40 having its second lead 34 in contact with the battery 60 (not shown, Column2, lines 18-20); and
- a first channel – a passage defined in the molded housing 36 (Figure 4) - in upper housing receiving one of the leads of the light source 40 (Figure 4); and the second channel – a passage defined in the molded housing 36 (Figure 4) - in the lower housing receiving the other of the leads of the light source 40 (Figure 4).

6. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hung (US Patent No.: 5,541,817), hereinafter referred as Hung, in view of Steeley (US Patent No.: 6,089,060)

Regarding Claim 4, Hung discloses the illuminated key blank 10 (Figure 1) comprising the casing 36 made from a flexible material. However, Hung does not disclose the casing specifically made from colored plastic.

On the other hand, Steeley ('060) discloses a key blank 11 (Figure 1) including an over molded layers formed from plastic (Figure 1, column 2, lines 51 and 52).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the key blank of Hung by enveloping the key head with plastic as taught by Steeley ('060) for the benefits of protecting the operationally vital internals supporting the light source from mechanical and chemical abuses.

Additionally neither combined nor individual teaching of Hung and Steeley ('060) teaches the casing of the key head being formed from a colored plastic.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to form the casing from colored plastic, well known in the art, for ornamentation purpose, since it has been held that matters relating to ornamentation only which has no mechanical function cannot be relied upon to patentably distinguish the claimed invention over prior art.

Regarding Claim 5, Hung in view of Steeley ('060) discloses the illuminated key blank comprising a light source. However, neither combined nor individual teaching of Hung and Steeley ('060) discloses the light source emitting light specifically of the same color as that of the casing.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to provide a light source emitting colored light, well known in the art, for

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ornamentation purpose, since it has been held that matters relating to ornamentation only which has no mechanical function cannot be relied upon to patentably distinguish the claimed invention over prior art.

Regarding Claim 6, Hung in view of Steeley ('060) discloses the illuminated key blank comprising a light source. However, neither combined nor individual teaching of Hung and Steeley ('060) discloses the light source emitting light specifically of the contrasting color as that of the casing.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to provide a light source emitting colored light, well known in the art, for ornamentation purpose, since it has been held that matters relating to ornamentation only which has no mechanical function cannot be relied upon to patentably distinguish the claimed invention over prior art.

7. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hung (US Patent No.: 5,541,817), hereinafter referred as Hung, in view of Sharrah (US Patent No.: 6,609,811 B1).

Regarding Claims 20 and 21, Hung does not teach the upper casing having a hole providing accessibility to an actuator for the light source.

On the other hand, Hung discloses an illuminated key bank 10 (Figure 1) comprising:

- surface switch including an electrically conductive strip 38- acting as an electrically conductive spring – positioned under the upper wall of the

casing 36, and pressing of the strip 38 electrically couples the battery 60 and the light source 40 (Figures 1 and 4, column 2, lines 4-6 and 25-28).

On the other hand, Sharrah ('811 B1) discloses an illuminated key including a conventional actuator 39 accessible through a hole 38 defined in the upper housing 32 (Figure 2, column 3, lines 14-18).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to recognize operational equivalency of the surface switch as taught by Hung and the conventional switch disclosed by Sharrah ('811 B1), and well known in the art. Therefore, because these two switches were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the switch taught by Hung with that taught by Sharrah ('811B1).

8. Claims 23-25, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hung (US Patent No.: 5,541,817), hereinafter referred as Hung, in view of Steeley (US Patent No.: 6,089,060) and Fetter (US Patent No.: 1,8,16,642).

Regarding Claim 23, Hung in view of Steeley ('060) discloses an illuminated key bank 10 (Figure 1) meeting all limitations of the first key blank recited in Claim 23 in the similar manner as that for rejections of claims 1 and 4 detailed above in sections 3 and 4 of this office action.

However, neither in combined not individual teaching of Hung and Steeley ('060) discloses an additional second key blank. Except the following, the claimed second key blank has the limitations similar to that of the first key blank discussed above. The

claimed second key blank includes a second casing of a second color different from that of the first casing of the first key blank.

On the other hand, Fetter ('642) discloses an identification system for keys including a set of three keys 2-4 each having a head bearing an identification mark of a color different from that of other keys (Figure 4, lines 37-42).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to provide to compile a set of keys by providing more than one keys each similar to that taught by Hung in view of Steeley ('060), and each of the keys bearing different color casing as taught by Fetter ('642), since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Further, provision of different color casing imparts benefits of color-coding for easy sorting and identification of the keys.

Regarding Claim 24, Hung in view of Steeley ('060) and Fetter ('642) discloses the set of to keys (Fetter, Figure 4), each key including a light source 40 and a casing enveloping the head of key blank (Hung, Figure 1).

However, neither combined nor individual teaching of Hung, Steeley ('060) and Fetter ('642) discloses the light source emitting light specifically of the same color as that of the casing.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to provide a light source emitting colored light, well known in the art, for ornamentation purpose, since it has been held that matters relating to ornamentation

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only which has no mechanical function cannot be relied upon to patentably distinguish the claimed invention over prior art.

Regarding Claim 25, Hung in view of Steeley ('060) and Fetter ('642) discloses the set of to keys (Fetter, Figure 4), each key including a light source 40 and a casing enveloping the head of key blank (Hung, Figure 1).

However, neither combined nor individual teaching of Hung, Steeley ('060) and Fetter ('642) discloses the light source emitting light specifically of the contrasting color as that of the casing.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to provide a light source emitting colored light, well known in the art, for ornamentation purpose, since it has been held that matters relating to ornamentation only which has no mechanical function cannot be relied upon to patentably distinguish the claimed invention over prior art.

Regarding each of claims 27 and 29, Hung in view of Steeley ('060) and Fetter ('642) discloses the set of the illuminated key blank meeting all limitations of each of claims 27 and 29 in similar manner as that for the rejection of Claim 23 detailed above.

Allowable Subject Matter

9. Claims 8 and 13-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record, including Sharrah (US Patent No.: 6,609,811 B1), does not show or suggest the applicant's invention as claimed. Specifically, the prior art of record does not disclose an illuminated key blank specifically combining:

- a main body of the key blank including a U-shaped head, and a battery disposed in the cutout between the arms of U-shaped heads as recited in claims 8 and 13;

The above-indicated combination, including a key blank with a U-shaped head, and a battery disposed in the cutout between the arms of U-shaped heads, makes this invention unique.

Claims 14-16 are necessarily objected because of their dependency on the objected base Claim 13.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

McGuire (U.S. Patent No. 6,817,217 B2), Seebock (U.S. Patent No. 6,244,722), Kuo (U.S. Patent No. 6,132,058), Wolter (U.S. Patent No. 4,562,712) and Chubb (U.S. Patent No. 4,349,975)

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hargobind S. Sawhney whose telephone number is 571 272 2380. The examiner can normally be reached on 6:15 - 2:45.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571 272 2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HSS

5/12/05


Stephen Husar
Primary Examiner